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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,655	04/23/2001	John Yin	515-A01-001	5026

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EXAMINER

NGUYEN, CUONG H

ART UNIT PAPER NUMBER

3625

DATE MAILED: 09/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/840,655	YIN ET AL.	
	Examiner	Art Unit	
	CUONG H. NGUYEN	3625	<i>NW</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6-13 and 19-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-13 and 19-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **Status of the Claims**

1. Claims 6-13, 19-27 are pending; claims 1-5, 14-18, and 28 are cancelled by the applicants on 6/01/2004.

### **Claim Rejections - 35 USC § 103**

*The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:*

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 6, 9-11, 13, 19, 23-24, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (US Pat. 6,591,272), in view of "Indigo Contrack®" article (see IDS, <http://www.indigosolutions.com/packagedapps.html>).**

Indigo ConTrack® - The Total Contract Management Solution gives artisan a benefit of knowing obligations, expiration dates, flexibility and growth, .etc. in management (see "Indigo Contrack®, pp.1-2).

**A. As to independent claim 6:** Williams discloses a method, comprising:

a) receiving critical items as defined by a client (see Williams, claims 3, 6, 7) - (critical items are defined as "metadata" - please note that it is obvious for "a contract previously has been executed by other parties" e.g., a sub-contract;

- b) receiving a rule based on said critical items (see Williams, claim 6); and
- c) executing said rule (see Williams, claim 6).

Williams does not disclose that critical items in a contract are represented by metadata.

However, Indigo Contrack® teaches that critical items are obligations of a party under an agreement (see Indigo Contrack®, page 1, 2<sup>nd</sup> para.).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Williams and Indigo Contrack® teachings to suggest a method for managing multiple interpretations from a single contract in a client-server environment because Indigo Contrack is the perfect software tool for determining exactly what commitments, both active and those in process; in another word, Indigo Contrack software is available to help a client takes control of a real contract.

**B. As to independent claim 19:** It is directed to a computer readable medium containing programming instructions for managing multiple interpretations from a single contract in a client-server environment, claimed programming instructions to perform similar steps as claim 6 although they are expressed in different claimed languages; therefore, similar rationales and references for rejection of claim 6 are also applied based on obviousness.

**C. As to dependent claim 9, 22:**

The rationales and reference to reject claim 6 are incorporated.

Williams suggests a step of receiving metadata which may comprise terms, conditions, dates, and payments (see Williams, claims 3, 6, 7); it would be obvious to one of ordinary skill in the art at the time of invention to comprise exactly terms, conditions, dates, and payments because a business contract would require a disclosure of those fundamental terms.

**D. As to dependent claims 10, 11, 23, 24:**

The rationales and reference to reject claim 6 are incorporated.

Williams suggests a step of receiving a user login (see Williams, claims 3, 6, 7); it would have been obvious to one of ordinary skill in the art at the time of invention to recognize that "that permits access only to predetermined areas of the contract upon which only metadata in the predetermined areas of the contract is subsequently received.", or "that permits access only to predetermined areas of the contract upon which rules in the predetermined areas of the contract can be subsequently executed." are merely intends of use the received content.

**E. As to dependent claims 13, 26:**

The rationales and reference to reject claim 6 are incorporated.

Williams suggests of receiving a rule from a client (see Williams, claims 3, 6).

Williams does not expressly disclose that a rule is selected from a menu driven template.

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Williams and Indigo software to receiving a rule from a client wherein a rule is selected from a menu driven template because receiving a rule from a client is crucial to the claimed method, it is not necessary that a rule MUST be selected from a menu driven template because it is well-known to select a predetermined rule.

**3. Claims 12, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (US Pat. 6,591,272), in view of the IDS: "Indigo Contract@" article, and further in view of Morgenstern (US Pat. 5,970,490).**

The rationales and reference to reject claim 6 are incorporated.

Williams receive a client metadata with a parsing process (see Williams, claims 3, 6, 7).

Williams does not expressly disclose about metadata is outlined/delineated by XML tags in the contract.

However, Morgenstern suggests that a metadata is outlined by XML tag (see Morgenstern, 45:65 to 46:5).

It would have been obvious to one of ordinary skill in

the art at the time of invention to combine Williams, Morgenstern, with Indigo software to suggest about using metadata in a contract, wherein that metadata is outlined/delineated by XML tag in the contract for a benefit of changeable metadata without updating each critical item in a document.

**4. Claims 7-8, 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (US Pat. 6,591,272), in view of the IDS: "Indigo Packaged Applications" article.**

The rationales and reference to reject claim 6 are incorporated.

Williams does not disclose about an instant notification in his client-server environment.

However, Indigo InstantNotifier® solution was designed to meet that limitation: "We can also send you updates via e-mail as development progresses" (see Indigo Packaged Applications pg.1, 2<sup>nd</sup> para.).

It is well-known that above "sending a notification" happen after executing that Indigo software.

It would have been obvious to one of ordinary skill in the art at the time of invention to implement Williams with Indigo software to suggest about sending a notification to a client after executing a rule/condition because a client always feel comfortable with a update status of a contract.

5. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (US Pat. 6,591,272), in view of the IDS: "Indigo Packaged Applications" article, and further in view of the IDS: "Indigo Contrack®" article.

This claim is directed to a method, comprising the above analyzed steps of:

- a) presenting on a graphical user interface, critical items/metadata of a contract which has been previously executed by different parties;
- b) selecting critical items/metadata; sending the critical items/metadata to another location;
- c) prompting a rule based on critical items;
- d) sending a rule to another location; and
- e) receiving a notification when a rule has been executed.

Williams does not disclose about an instant notification in a client-server environment (limitation e).

However, Indigo InstantNotifier® solution was designed to meet that limitation: "We can also send you updates via e-mail as development progresses" (see Indigo Packaged Applications pg.1, 2<sup>nd</sup> para.).

It is well-known that above "sending a notification" happen after executing that Indigo software.

The examiner respectfully submits that it would have been obvious to one of ordinary skill in the art at the time of invention to recognize these claimed limitations are



obvious based on the above analysis of rejected claims 6-13; although that claimed method happens on a different portion (a server side instead of a client side) - same interactions between a client and a server take place, the client and server machines still work together to accomplish the processing of the application being used; the client portion of the application is optimized for user interaction, whereas the server portion provides a centralized, multi-user functionality.

#### **Conclusion**

6. Claims 6-13, 19-27 are not patentable.
7. The attached prior art are pertinent to claimed subject matter of this pending application.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose number is 703-305-4553. The examiner can normally be reached on 7am-3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, JEFFREY A. SMITH can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Please provide support, with page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.

*Cuong H. Nguyen*

CUONG H. NGUYEN  
Primary Examiner  
Art Unit 3625